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09/961,363	09/25/2001	Takenori Idehara	011350-287	5946
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EXAMINER				
REFAI, RAMSEY				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/961,363

Applicant(s)

IDEHARA ET AL.

Examiner

RAMSEY REFAI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Responsive to Request for Continued Examination (RCE) filed October 10, 2007 and Supplemental Response filed November 9, 2007. Claims 46-71 remain pending further examination.

Response to Arguments

1. Applicant's arguments have been fully considered but they are not persuasive.
- Regarding the 112 first rejection of claims 67-68, the Applicant has submitted that paragraphs 0173-0175 of the Applicants' disclosure provide support for the limitations "where the wireless communication unit fails to communicate with the portable device after a predetermined time," and "when the portable terminal device is out of a range from the wireless communication unit based upon connection checks at a constant time interval" . In response, the Examiner withdraws the rejection of claim 68. However, claim 67 remains unsupported. The paragraphs cited lack support for the limitation "where the wireless communication unit fails to communicate with the portable device after a predetermined time" . The paragraphs teach connection checks at constant time intervals but fail to teach the failure to communicate with the portable device after a predetermined time. It is also noted that paragraph 0174 is unclear on what occurs during the connection checks. It includes a feature wherein the printer " **severs the connection** as soon as it **establishes the connection**" . Clarification is requested on how and why the connection is severed as soon as the connection is established. Rejection for claim 67 is maintained.

Affidavit/Declaration

- Regarding the 1.131 declaration filed November 9, 2007, attempting to disqualify Lazaridis et al as prior art, the Examiner asserts that the 1.131 is insufficient for at least the following reasons:

a. All inventors of the subject matter claimed have not signed the declaration.

b. The Applicants have not given a clear explanation of how these exhibits commensurate with the claimed invention. The Examiner requests that the Applicant cite the specific section(s) of the exhibits that support each claimed limitation. The exhibits appear to show the process that led to the filing of foreign application (priority # 2000-296861) dated 09/28/2000. However, the present application also claims priority to foreign application (priority # 2000-363581) dated 11/29/00. Therefore, it is unclear which claimed limitation(s) are properly supported by the foreign application filed 09/28/2000.

MPEP paragraph 715.07 recites:

"The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29(CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred ")

Examiner is not questioning the validity of exhibits, but requires that all exhibits be explained clearly and in detail, to the satisfaction of the Examiner, and also how these exhibits commensurate with the claimed invention.

Claim Rejections – 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended claim 67 further limit parent claim 66 by discussing the certain condition that is satisfied for deleting the device information by the controller. Claim 67 discusses deleting device information if a certain condition is satisfied “ wherein the certain condition includes a condition where the wireless communication unit fails to communicate with the portable terminal device after a predetermined time.” No support for such limitations can be found in the Applicant’s disclosure.

Claim Rejections – 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 46-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Lazaridis et al (U.S. Patent No. 7,000,001).

6. As per claim 46, Lazaridis et al teach a data transmission device (**Fig 5, element 74; message server**) to be used in a system including said data transmission device and a data receiving device (**Fig 5, element 72; printer**) which are connected to a data network (**Fig 5, element 18; Internet**), and at least one portable terminal (**Fig. 5, element 14**) said data transmission device comprising:

a first transmission unit transmitting to said portable terminal without recourse to said data network a signal for obtaining device information from said data receiving device, the data receiving device information containing connection information for establishing a connection between said data transmission device and said data receiving device (**column 6, lines 33-51; server gives the user the option to print the attachment at a network-enabled printer. user then transmits printer address information to server**);

a receiving unit for receiving the data receiving device information from said portable terminal without recourse to said data network (**Fig 5; printer address information is received wirelessly from portable device through wireless network**); and

a second transmission unit for transmitting to said data receiving device a signal for requesting a connection based on the device information using said data network (**Fig. 5, step 5,**

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column 6, lines 61-63; server transmits attachment through internet to printer specified by the user using received printer address information).

7. As per claim 47, Lazaridis et al teach the second transmission unit transmits data to said data receiving device via said data network after establishing a connection with said data receiving device **(column 6, lines 60-61; attachment transmitted after connection with printer is established).**

8. As per claim 48, Lazaridis et al teach said first transmission unit and said receiving unit transmit and receive data with said portable terminal via mobile telecommunication network **(Fig 5, element 16; wireless network).**

9. As per claim 49, Lazaridis et al teach said connection information contains an identification code for identifying said data receiving device on said data network **(column 5, line 15, column 2, lines 37-41; IP address/URL)**

10. As per claim 50, Lazaridis et al teach said identification code is an IP address **(column 5, line 15, column 2, lines 37-41; IP address/URL).**

11. As per claim 51, Lazaridis et al teach a data receiving device to be used in a system including a data transmission device and said data receiving device which are connected to a data network, and at least one portable terminal said data receiving device comprising:

a transmission unit for transmitting data receiving device information to said portable terminal without recourse to said data network according to a request signal received from said

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portable terminal without recourse to said data network, the data receiving device information containing connection information for establishing a connection between said data transmission device and said data receiving device (column 6, lines 33-51; **server gives the user the option to print the attachment at a network-enabled printer. user then transmits printer address information to server**); and

a connection unit for establishing a connection with said data transmission device according to a signal for requesting the connection transmitted from said data transmission device based on the device information (Fig. 5, step 5, column 6, lines 61-63; **server transmits attachment through internet to printer specified by the user using received printer address information**).

12. As per claim 52, Lazaridis et al teach said transmission unit comprises a communication unit communicating in short distances for transmitting the device information to said portable terminal (column 3, lines 16-32; IrDA)

13. As per claim 53, Lazaridis et al teach said communication means for communicating in short distances is a wireless communication means (Fig 5, element 16, column 3, lines 16-32; IrDA).

14. As per claim 54 A data receiving device as claimed in claim 53, in which said communication means for communicating in short distances is based on either Bluetooth, IEEE 802.11, HomeRF, or IrDA(column 3, lines 16-32; IrDA).

15. As per claim 55, Lazaridis et al teach which said communication unit comprises a wired communication unit **(Fig 5; internet).**

16. As per claim 56, Lazaridis et al teach said connection information contains an identification code for identifying said data receiving device on said data network **(column 5, line 15, column 2, lines 37-41; IP address/URL)**

17. As per claim 57, Lazaridis et al teach said identification code is an IP address **(column 5, line 15, column 2, lines 37-41)**

18. As per claim 58, Lazaridis et al teach a portable terminal to be used in a system including a data transmission device and a data receiving device which are connected to a data network, and said portable terminal said portable terminal comprising:

a first transmission unit for transmitting to said data receiving device a signal for requesting transmission of device information according to a request from said data transmission device, the device information containing connection information for establishing a connection between said data transmission device and said data receiving device **(column 6, lines 33-51; server gives the user the option to print the attachment at a network-enabled printer. user then transmits printer address information to server);**

a receiving unit for receiving the device information from said data receiving device **(Fig 5; printer address information is received wirelessly from portable device through wireless network);** and

a second transmission unit for transmitting the device information received from said data receiving device to said data transmission device **(Fig. 5, step 5, column 6, lines 61-63;**

server transmits attachment through internet to printer specified by the user using received printer address information).

19. As per claim 59, Lazaridis et al teach said first transmission unit and said receiving unit comprise a communication unit communicating in short distances for transmitting and receiving data with said data receiving device **(column 3, lines 16-32; IrDA).**

20. As per claim 60, Lazaridis et al teach portable terminal said communication means for communicating in short distances is a wireless communication means **(column 3, lines 16-32; IrDA).**

21. As per claim 61. A portable terminal as claimed in claim 60, in which said communication means for communicating in short distances is based on either Bluetooth, IEEE 802.11, HomeRF or IrDA **(column 3, lines 16-32; IrDA).**

22. As per claim 62, Lazaridis et al teach said communication unit comprises a wired communication unit **(Fig 5, element 18; internet).**

23. As per claim 63, Lazaridis et al teach said second transmission means transmits the device information to said data transmission device via a mobile telecommunication network **(Fig 5, element 16; wireless network).**

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24. As per claim 64, Lazaridis et al teach said connection information contains an identification code for identifying said data receiving device on said data network (**column 5, line 15, column 2, lines 37-41; IP address/URL**).

25. As per claim 65, Lazaridis et al teach said identification code is an IP address (**column 5, line 15, column 2, lines 37-41**).

Claim Rejections – 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 66-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazaridis et al.

28. As per claim 66, Lazaridis et al teach a data receiving device to be used in a system including a data transmission device and said data receiving device which are connected to a data network, and a portable terminal, said data receiving device comprising:

a wireless communication unit for receiving device information of said data transmission device from said portable terminal without recourse to said data network, the device information containing connection information for establishing a connection between said data transmission device and said data receiving device using said data network (**column 6, lines 33-51, Fig 5; printer address information is received wirelessly from portable device through wireless network**).

Lazaridis et al fail to explicitly teach a controller for deleting the device information if a certain condition is satisfied. However, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include a feature of deleting the received address information from the server memory once the task of printing the attachment has been completed in Lazaridis et al's system because it would increase functionality of the server by freeing up the server's memory of unnecessary data, such as the printer address information, which is no longer needed once the task of printing the attachment has been completed.

29. As per claims 67 and 68, Lazaridis et al fail to teach deleting the information *when the wireless communication unit fails to communicate with the portable terminal device after a predetermined time or when the portable terminal device is out of a range from the wireless communication unit based upon connection checks at a constant time interval*. However, it would have been obvious to one of ordinary skill in the art to modify Lazaridis et al to include such features because doing so would lead to an efficient use of memory. If the device is no longer in communication, then information is no longer needed and therefore will be deleted.

30. As per claim 69. A portable terminal as claimed in claim 60, in which said communication means for communicating in short distances is based on either Bluetooth, IEEE 802.11, HomeRF or IrDA (**column 3, lines 16-32; IrDA**).

31. As per claim 70, Lazaridis et al teach said connection information contains an identification code for identifying said data receiving device on said data network (**column 5, line 15, column 2, lines 37-41; IP address/URL**).

32. As per claim 71, Lazaridis et al teach said identification code is an IP address (**column 5, line 15, column 2, lines 37-41**).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAMSEY REFAI whose telephone number is (571)272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ramsey Refai
December 16, 2007
/R. R./
Examiner, Art Unit 3627

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627